

Appl. No. 09/909,233
Atty. Docket No. CM2505
Amdt. dated 6/23/06
Reply to Office Action of 4/5/06
Customer No. 27752

REMARKS/ARGUMENTS

Claims 1-8, 12, 14-16, 18-29, 35 and 41-42 are currently under consideration.
Claims 36-40 are withdrawn from consideration.

Claim 1 (and, perforce, all claims depending directly or indirectly therefrom) has been amended to recite the sol/gel laponite mixture (basis at page 13, lines 17-20 and page 47, line 1 – mixture of sol/gel laponites). The platelet size has been deleted. The pH range of 11.5 the 13.5 has been inserted. (Basis at page 4, line 3.)

It is submitted that all amendments are supported and entry is requested.

Rejections Under 35 USC 112

It is submitted that the amendments presented herein fully meet the rejections under §112 at pages 3-4 of the Office Action. Briefly stated, none of the terms cited by the Examiner now appears in the amended claims. Withdrawal of all rejections under §112 is therefore requested.

Rejections Under 35 USC 103

Claims 1-8, 10, 12, 14-29, 35, 41 and 42 stand rejected over JP60-141800 in view of US 6,194,362, US 5,202,050, JP8-151,597 and US 5,739,092, for reasons of record at pages 6-10 of the Office Action.

Applicants respectfully traverse all rejections, to the extent they may apply to the claims as now amended.

All previous arguments in support of patentability continue to apply, but will not be exhaustively repeated herein, for the sake of brevity.

It is first noted that, in several instances [e.g., Office Action pages 5, 8 and 9 (thrice)] the Examiner resorts to invoking “one of ordinary skill in the art” in order to supply various features or suggestions to combine the teachings of various cited documents. It is submitted that it is improper under §103.

In fact, the BPAI was taken to task by the CAFC on this very point in *In re Denis Rouffet, Yannick Tanguy and Frederic Berthault*, 149 F.3d 1350; 1998 US App. LEXIS 16414; 47 USPQ 20 (BNA) 1453 (LEXIS @ page 121). In reversing the Board, the

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CAFC relied on a well-established line of cases which establishes the principle, "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references." Importantly, the CAFC made it abundantly clear that recourse to "skill-in-the-art" is not sufficient basis for combining references under §103 obviousness standards. The Court further stated:

The Board's naked invocation of skill in the art to supply a suggestion to combine the references cited in this case is therefore clearly erroneous. Absent any proper motivation to combine [parts of the various references] the rejection of Rouffet's claim . . . is reversed.

The Board was also reversed on this same point in the *In re Anita Dembiczak and Benson Zinbarg* (Jack-O-Lantern trash bag case), 175 F.3d 994; 1999 US App. LEXIS 8109; 50 USPQ 2d (BNA) 1614. Again, the Court noted (LEXIS @ page 75):

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. [Citation omitted]

Moreover:

. . . this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the [cited references] teach or suggest their combination to yield the claimed invention. (LEXIS @ page 76)

The Board was reversed yet again on similar grounds in *In re Dow Chemical Company* 837 F.2d 469; 1988 US App LEXIS 587; 5 USPQ 2D (BNA) 1529 (LEXIS @ page 151). Citing controlling case law (LEXIS page 153), the Court said:

The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this

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process should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. [Citations omitted] Both the suggestion and the expectation of success must be found in the prior art, not in the Applicant's disclosure. [emphasis supplied]

Furthermore and in particular regard to JP '800, as the Examiner has previously noted at page 3 of the Office Action of 11/3/05, "Further, the addition of the word 'type' to an otherwise definite expression extends the scope of the expression so as to render it indefinite," citing MPEP 2173.05(c).

That being the case, the expression "smectite-type clay minerals" appearing at page 4, line 9 of the primary reference JP '800 must be considered indefinite, such that it cannot meet §112. Due to this indefiniteness, the "smectite-type" clay term used in JP '800 cannot constitute citable matter against the present invention. Accordingly, only those clays specifically disclosed in JP '800 (e.g., at page 4, lines 10-11) meet §112 with respect to their potential impact as §103 art.

In short, laponite clay, under the foregoing analysis, cannot be contemplated by JP '800, as a matter of law, since the term smectite-"type" clearly is indefinite under MPEP 2173.05(c) and therefore of no value as a prior art teaching under §103. Since JP '800 does not disclose laponite, it cannot be suggestive of the laponites used herein.

In any event, the JP '800 document focuses on swellable clays and does not at all suggest their use with gums, especially xanthan, in the manner of the present invention. In this regard, JP '800 appears to be no more instructive than JP 8151597 discussed below.

As discussed in the previous responsive amendments, JP '597 explicitly discloses the "thread pulling" properties of organic-type thickeners. To avoid the thread pulling problem, JP '597 replaces organic thickeners with clay thickeners. In view of JP '597's exposition of this "problem," no rationale for use of gums of any type with clays of any type would appear to afford grounds for combining JP 597 with any of the other cited documents, per the case law discussed above.

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In short, whatever else JP '597 teaches, it clearly discloses that the properties of organic thickeners are different from clay thickeners, and that clay should be substituted for – not admixed with – organic thickeners.

Respectfully, having made JP '597 of record, the Examiner cannot now ignore the full breadth of its disclosures. Clearly, those disclosures can fairly be said to teach away from mixing the two classes of thickeners in compositions of the present type. As stated by the CAFC in *Bausch & Lomb, Inc. v. Barnes-Hind Hydrocurve, Inc., and Barnes-Hind International, Inc.*, 796 F.2d 443; 1986 US App LEXIS 20297; 230 USPQ (BNA) 416 (@ LEXIS page 11):

It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such a reference fairly suggests to one skilled in the art.

To recap: The primary reference JP '800 does not suggest laponite clays, much less the sol/gel laponite combination used herein. Moreover, JP '800 is silent with regard to xanthan gum/clay combinations.

The secondary reference JP '597 teaches that gums exhibit a thread-pulling problem and, therefore, totally replaces gums with clays. The document makes no suggestion that clay/gum combinations would be satisfactory (in view of the stated gum problem) for any purpose whatsoever.

US '362 teaches an in-use pH of about 7 to about 11 (column 15, lines 34-35). The compositions are designed to deliver good (glass) cleaning performance without filming/streaking. See column 1, lines 44-49. Various solvents are listed at column 14 – column 15, but organoamines do not appear to be contemplated.

While various optional ingredients are listed in '362 at columns 15-16, clay or clay/gum combinations do not appear to be suggested. Presumably, this is because the disclosed compositions are intended to have good filming/streaking characteristics on glass.

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In summary, while various and sundry of the individual ingredients herein may be disclosed in the cited combination of documents, it is submitted that their combination in the manner suggested in the rejections is a matter of impermissible hindsight. This is especially true with regard to the cited "all-clay" Japanese documents. Moreover, even if properly combined, all elements of the pH organoamine/solvent plus perfume/spray droplet size system herein are not fairly suggested, in the sense of §103.

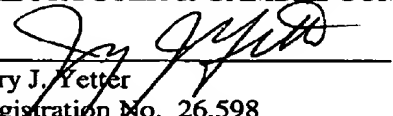
The '050 and '092 documents have been cited to show various features of the present compositions, including a pH of 5-11. As noted above in *Dembiczak*, such a feature-by-feature analysis of documents is not the test for their combinability under §103. And, even if properly combined, the sol/gel laponite/gum mixtures herein are still not suggested thereby.

In light of the foregoing, withdrawal of all rejections as with respect to the amended claims is requested.

Respectfully submitted,

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